

REMARKS

Favorable reconsideration of this application is requested in view of the above amendments and following remarks. Claims 1, 2, 6 and 7 are amended. Support for the amendments can be found on at least page 14, lines 6-8 of Applicants' Specification. No new matter has been added. Claims 1-7, 9 and 11 are pending in the application. Reconsideration of the claims is respectfully requested.

In paragraph 2 on page 3 of the Final Office Action dated September 6, 2005, claims 1 and 2 were finally rejected under 35 USC § 102(b) as being anticipated by Zeiter et al. (6,494,491). In paragraph 2 on page 4 of the Final Office Action, claims 3-5 were finally rejected under 35 USC § 103(a) as being unpatentable over Zeiter et al. in view of Yamauchi et al. (5,575,507). In paragraph 3 on page 5 of the Final Office Action, claim 5 was finally rejected under 35 USC § 103(a) as being unpatentable over Zeiter et al. in view of Waldhoff (5,316,343). In paragraph 4 on page 5 of the Final Office Action, claims 6, 7 and 9 were finally rejected under 35 USC § 103(a) as being unpatentable over Yamauchi et al. Applicants respectfully traverse the rejections.

Zeiter fails to teach or suggest at least a protective overlayer selectively applied on said image-receiving layer to form a second machine-readable indicia of varying thicknesses as recited in Applicants' claim 1. Rather, Zeiter discloses that a transparent plastic film 10 has images 12, 14 on both sides a distance d apart. Col. 5, lines 23-25. At best, Zeiter discloses overlapping images separated by a plastic film in which additional uniform outer layers 22, 24 can be laminated onto the plastic film. Col. 6, lines 9-12. Zeiter's protective layer 10 is not selectively applied on an image-receiving layer to form a second machine-readable indicia of varying thicknesses.

Yamauchi fails to remedy the deficiencies of Zeiter as Yamauchi also fails to teach or suggest at least a protective overlayer selectively applied on said image-receiving layer to form a second machine-readable indicia of varying thicknesses. Rather, Yamauchi merely provides a uniform protective layer 56 over an information layer to protect the information layer. Furthermore, the uniform protective layer 56 is a separate step and a separate layer from the information layer. Col. 23, line 67 – Col. 24, line 8. Yamauchi's protective layer

56 is not selectively applied on an image-receiving layer to form a second machine-readable indicia of varying thicknesses.

Thus, it is submitted that further consideration of claim rejections under 35 USC 103(a) upon the citing of the third applied prior art reference to Waldhoff is moot, inasmuch as the combination of Zeiter, Yamauchi and Waldhoff still lack any teaching, disclosure, or suggestion concerning a protective overlayer selectively applied on said image-receiving layer to form a second machine-readable indicia of varying thicknesses as previously discussed.

Also, Applicants respectfully submit that the Examiner bears the burden of establishing a prima facie case of obviousness based upon the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. *In re Gordon*, 733 F.2d at 902, 221 USPQ at 1127. Applicants respectfully request that the Examiner submit an affidavit as to the Examiner's personal knowledge or submit a prior art reference suggesting the desirability of modification.

Further, Applicants submit that Applicants' protective overlayer forming machine-readable indicia of varying thicknesses is novel and unobvious in that it has structure and function, which is required for patentability. Applicants submit that the protective overlayer selectively applied on the image-receiving layer to form a second machine-readable indicia of varying thicknesses enhances the machine readability. This specifies at least the required functional relationship to carry out Applicants' invention and clearly defines the disclosed invention as required by section 112. "The fact that printed matter by itself is not patentable subject matter, because non-statutory, is no reason for ignoring it when the claim is directed to a combination." *In re Miller*, 418 F.2d 1392, 1395; 164 USPQ 46, 48 (1969).

In view of the above remarks, Applicants respectfully submit that claim 1 is patentable over the cited references. Rejected independent claims 2, 6 and 7 recite one or more feature generally similar to those of claim 1 discussed above and, for similar reasons as discussed above, are believed to be patentable over the cited references. Because claims 3-5, 11 and 9 depend from claims 2 and 7, respectively, and include the features recited in the independent claims as well

as additional features, Applicants respectfully submit that claims 3-5, 9 and 11 are also patentably distinct over the cited references.

In view of the foregoing it is respectfully submitted that the claims in their present form are in condition for allowance and such action is respectfully requested.

Respectfully submitted,



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If the Examiner is unable to reach the Applicant(s) Attorney at the telephone number provided, the Examiner is requested to communicate with Eastman Kodak Company Patent Operations at (585) 477-4656.